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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,739	11/30/2001	Claude A. Marbler	ATM-2301	4484

7590

09/23/2005

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

12

Office Action Summary	Application No. 09/996,739	Applicant(s) MARBLER ET AL	
	Examiner Jane Rhee	Art Unit 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,13,17,20,22,24,27,49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-13,17,20,22,24,27,49-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

✓

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/20/2005 has been entered.

Rejections Withdrawn

2. The 35 U.S.C. 102(b) rejection of claims 12-13,17,27 as anticipated by Niwa has been withdrawn due to applicant's amendment filed on 7/20/2005.
3. The 35 U.S.C. 103(a) rejection of claims 16,23-24 over Niwa in view of Olivieri et al. has been withdrawn due to applicant's amendment filed on 7/20/2005.
4. The 35 U.S.C. 103(a) rejection of claims 20-22 over Niwa in view of Schlaeppi has been withdrawn due to applicant's amendment filed on 7/20/2005.

Rejections Repeated

5. The 35 U.S.C. 112 first paragraph of claims 12-17, 20-24, 27 has been repeated as previously made in office action 3/23/2005.

Specification

6. The amendment filed 7/20/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment

shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In one version of the invention there can be no other layer in contact with the plastic film during the cutting of the at least one line of perfection.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter issue is "at least two lines."

Applicant has support for "at least one line" or "two lines" but not "at least two lines."

8. Claims 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter issue is "dividing the multi-layer packaging film into at least two parts, " and "a notch in the opposite edge of at least

another part of the multilayer packaging film". Also, "each at least one line of perforations and the notch of each of the one part with the another part are aligned with each other" is new matter.

9. Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter issue is "dividing the multi-layer packaging film into at least two parts, " and "a notch in the opposite edge of at least another part of the multilayer packaging film". Also, "each at least one line of perforations and the notch of each of the one part with the another part are aligned with each other" is new matter. Furthermore, "the plastic film having at least one line of perforations of the one part and the another part of the pouch is situated on the inner side of the pouch" is new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 12-13,17,24,27 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa in view of Olivieri et al.

Niwa discloses a process for preparing a multilayer packaging (col. 1 lines 1-3), comprising cutting at least one line of perforations completely through a plastic film consisting of a single plastic film (col. 3 lines 15-20), that is to be a precut, surface plastic layer of the multilayer packaging film (figure 1 number 4), there being no other layer in contact with the plastic film during the cutting of the at least one line of perforations (col. 3 lines 15-25), each of the at least one line of perforations extending from edge to edge of the plastic film (figure 3 number 7), and joining the precut plastic layer with at least one other layer to form the multilayer packaging film (col. 3 lines 22-25), and providing a notch in one edge of the multilayer packing film in the region of the perforations for initiating tearing along the tear line (col. 3 lines 35-48), the at least one line of perforations serve as an aid for alignment of the tear line propagating in the multilayer packaging film upon tearing open the packaging (col. 3 lines 44-48), the packaging being easy to open by means of the tear line and the notch (col. 3 lines 35-38). Niwa discloses that the precut plastic layer is joined to the last one other layer by means of an adhesive layer to make up the multilayer film (col. 3 lines 22-25). Niwa discloses that wherein two lines of perforations are cut parallel or substantially parallel to each other at a distance apart as guidelines on both sides of a tear which propagates in the packaging film on tearing open (col. 3 line 50). Niwa discloses wherein the packaging film is employed for the production of pouch forms of packaging by sealing edges of the one part with the edges of another part that is positioned so that the each at least one line of perforations and the notch of each of the one part with the another part are aligned with each other (col. 3 lines 31-34).

Niwa fail to disclose that the notch is situated between the two lines of perforations. Olivieri et al. teaches that the notch is situated between the two lines of perforations (figure 8a number 431) for the purpose of tearing the materials forming the pack (col. 8 lines 57-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Niwa with the notch that is situated between the two lines of perforations in order to tear the materials forming the pack (col. 8 lines 57-58) as taught by Olivieri et al.

11. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa (EP 0468619) in view of Olivieri et al. and in further view of Schlaeppi (EP 0596747).

Niwa discloses the process for preparing a multilayer packaging film for a packaging as described above. Niwa fail to disclose wherein the precut plastic layer is joined to the at least one other layer by means of extrusion to make up the multi-layered film. Schlaeppi teaches that it is well known in the art to secure the other layer to the inner layer by an adhesive or by other lamination or extrusion coating techniques (col. 4 lines 19-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Niwa with the precut plastic layer that is joined to the at least one other layer by means of extrusion to make up the multi-layered film as it is notoriously well known in the art to secure the other layer to the

inner layer by an adhesive or by other lamination or extrusion coating techniques (col. 4 lines 19-21) as taught by Schlaeppli.

Response to Arguments

12. Applicant's arguments filed 7/20/2005 have been fully considered but they are not persuasive.

In response to applicant's argument the examiner's notes have been inconsistent because the examiner can not correctly take a position in one rejection and then an opposite position in the same matter in another rejection, first of all, applicant is claiming a negative limitation and according to the MPEP, any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234,1236 (Bd. Pat. App. & Inter. 1993). Secondly, figure 1 does not support the limitation "there being no other layer in contact with the plastic film during the cutting of the at least one line of perforations" because figure 1 is not directed to process but an article. Thirdly, specification page 2 lines 29-30 does not support the above limitation because it clearly states that "the layer of adhesive 16 may if desired *already* be present on the inner layer 14 *before* the cutting is performed." Fourthly, the burden is not on the examiner to *prove* that the process claim has new matter and to factually establish that the subject process phrase is not disclosed in the specification, new matter issue is based on the fact that the specification has no support for the new

matter issue, therefore, obviously since a new matter rejection was made, the examiner did not find support for the new matter in the specification. Thus, the need to “prove” or “factually establish” the subject process phrase makes no sense because it’s either supported by the specification or not supported by the specification. Finally, as to the inconsistency of the examiner’s notes that the applicant disagrees with, applicant’s claims are broadly examined by the examiner, hence the broad interpretation of the reference used to rejection the claims however, the specification disclosed by the applicant should clearly disclose applicant’s invention and not need to be interpreted by the examiner in order to figure out applicant’s invention, thus the reason for the inconsistency.

In response to applicant’s argument that Niwa fail to disclose a notch that is situated between the two lines of the perforations, Olivieri et al. teaches that the notch is situated between the two lines of perforations (figure 8a number 431) for the purpose of tearing the materials forming the pack (col. 8 lines 57-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant’s invention was made to provide Niwa with the notch that is situated between the two lines of perforations in order to tear the materials forming the pack (col. 8 lines 57-58) as taught by Olivieri et al.

In response to applicant’s argument that Olivier et al. teaches away from applicant’s claimed invention because Olivier et al. only discloses forming perforations in a lower plastic layer of an already formed multilayer film after the multilayer film has been formed, Olivier et al. does not teach away from applicant’s invention because

Niwa teaches the process of preparing a multilayer packaging film and Olivier teaches a notch situated between the two lines of perforations. The Olivier reference was not used to teach the process limitation of applicant's multilayer packaging film but to teach a notch situated between the two lines of perforations.

In response to applicant's argument that Schlaeppi et al. teaches away from the use of a notch because of problems associated with the use of notches, Schlaeppi et al. was used to teach that it is well known in the art to secure the other layer to the inner layer by an adhesive or by other lamination or extrusion coating techniques (col. 4 lines 19-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Niwa with the precut plastic layer that is joined to the at least one other layer by means of extrusion to make up the multilayered film as it is notoriously well known in the art to secure the other layer to the inner layer by an adhesive or by other lamination or extrusion coating techniques (col. 4 lines 19-21) as taught by Schlaeppi.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
September 18, 2005

SUSY TSANG-FOSTER
PRIMARY EXAMINER

